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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 10/020,779 | 12/14/2001 | Scott R. Swix | 36968.265393 (BS01377) | 9532 |

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07/17/2007

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| EXAMINER |
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VAN BRAMER, JOHN W

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| ART UNIT | PAPER NUMBER |
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3622

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| MAIL DATE | DELIVERY MODE |
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07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/020,779 | Applicant(s) SWIX ET AL. | |
| | Examiner John Van Bramer | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>31102</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on April 30, 2007 cancelled no claims. Amendments were made to claims 1, 3, 9, 12, 14, 17, 19, and 20. No new claims were added. Thus, the currently pending claims addressed in this Office Action are 1-6, 8, 9, 11-15, and 17-20.

Claim Objections

2. Claims 17-20 still maintain reference to the advertisement "time slot" having the overrideable categorization, which was restricted by original presentation in Notice of Non-Compliance, mailed April 4, 2007 (see Claim 17: "The processor determining whether the advertisement time slot is categorized as overrideable"). As the applicant's remarks and other amendments indicated an attempt to comply with the restriction by original presentation, the examiner has prosecuted Claim 17 as if the applicant had amended the claim to read: "The processor determining whether the advertisement is categorized as overrideable". Corrective action is required in order to prevent the restriction of Claims 17-20 in the next Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-9, 11-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (PGPUB: 2002/0083441) in view of Gupta et al. (U.S. Patent Number: 6,487,538)

Claims 1, 9 and 17: Flickinger discloses an advertisement management method and system, comprising:

- a. Receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot. (Page 2, Paragraph [0030] and Page 3, Paragraph [0042])
- b. Receiving an advertiser's request to replace the advertisement with a different advertisement. (Page 4, Paragraphs [0047]-[0051])
- c. Determining an advertisement is replaceable by a different advertisement, and the different advertisement is nearly equal in time length to the advertisement. (Page 3, Paragraph [0042] and Page 5, Paragraph [0063])
- d. Replacing the advertisement with the different advertisement. (Page 3, Paragraphs [0042]-[0044])

While Flickinger is silent with regard to the advertisement itself including a categorization as to whether it is overrideable or non-overrideable, he does disclose that on Page 4, Paragraphs [0054]-[0056] that each ad can have tags

associated with it and that these tags are detected by the set top STB and used to determine when and how to display the ad. The analogous art of Gupta et al. (U.S. Patent Number: 6,487,538) discloses that advertisements can be specified as unable to be overridden or replaceable (Col 12, line 51 through Col 13, line 42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify whether an ad is overrideable or non-overrideable in the tags disclosed by Flickinger. One would have been motivated to include such tags in order to ensure that advertisers that have paid for a National Advertisement that is intended for all viewers (such as may Super Bowl advertisements)

Claims 2, 11, and 18: Flickinger and Gupta disclose the methods and system of claims 1, 9 and 17 respectively, further comprising receiving a premium to replace the advertisement. (Gupta: Col 12, line 51 through Col 13, line 42)

Claims 3, 12, and 19: Flickinger and Gupta disclose the methods and system of claims 1, 9 and 17 respectively, wherein the overrideable advertisement is priced at a lower cost than the non-overrideable advertisement. (Gupta: Col 12, line 51 through Col 13, line 42)

Claims 4, 13, and 20: Flickinger and Gupta disclose the methods and system of claims 1, 9 and 17 respectively, further comprising providing data regarding viewing

habits that distinguishes more-valuable viewers from less-valuable viewers.

(Flickinger: Page 5, Paragraph [0064])

Claims 5 and 14: Flickinger discloses the method of claims 1 and 13 respectively, further comprising matching advertisements with the more-valuable viewers and with the less-valuable viewers. (Flickinger: Page 5, Paragraph [0064])

Claims 6 and 15: Flickinger discloses the method of claims 1 and 9 respectively, further comprising wherein at least one of: broadcasting the programming content as a television broadcast, broadcasting the programming content as a radio broadcast, and broadcasting the programming content over a network. (Flickinger: Page 3, Paragraph [0041] and Page 5, Paragraph [0064])

Claim 8: Flickinger discloses the method of claim 1, further comprising creating a log of events viewed by potential customers. (Flickinger: Page 4, Paragraph [0051] and Page 8, Paragraph [0097])

Response to Arguments

5. The Applicant's arguments with respect to amended independent claims 1, 9, and 17 have been persuasive and necessitated the new ground(s) of rejection presented in this Office Action. In view of the new grounds of rejection the

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applicant's arguments regarding prior art used in previous Office Actions have been rendered moot.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is


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(571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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